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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,690	10/03/2003	Ian A. Cody	JJK-0331 (P2002J100)	9954
27810	7590	05/04/2005	EXAMINER	
EXXONMOBIL RESEARCH AND ENGINEERING COMPANY P.O. BOX 900 1545 ROUTE 22 EAST ANNANDALE, NJ 08801-0900			NGUYEN, TAM M	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,690

Applicant(s)

CODY ET AL.

Examiner

Tam M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-68 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/16/04; 6/01/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-68 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-68 of copending Application No. 10/678,690. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 9-12, 14-18, 20-23, 26-30, 32-34, 36, 37, 48-52, 54-58, 60-63, 66, and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by LaPierre et al. (4,431,519).

LaPierre discloses a hydrodewaxing process of a hydrocarbon feed comprising about 0.01 wt. % to about 10 wt.% of an oxygenate such as methanol by contacting the feed, which comprises greater than 15 wt. % of wax (e.g., paraffins) and about 0.082 wt. % of sulfur, with a

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catalyst comprising ZSM-5. The hydrodewaxing process is operated at a temperature of from 650 to 1000° F, at a pressure of from 100 to 3000 psig (689-20,684 kPa), a LHSV of from 0.1 to 10. The catalyst comprises a metal of group 9. LaPierre also discloses that it is may be desirable to make the addition of methanol to the oil in an intermittent or pulsing fashion rather than on a continual basis. It is noted that LaPierre does specifically that the process is operated at a hydrogen partial pressure of from 791 to 207886 kPa. However, LaPierre teaches that the hydrogen to hydrocarbon feed mole ratio is between 1 and 20. Therefore, it is estimated that the LaPierre hydrogen partial pressure is within the claimed ranges. (See col. 2, lines 6-36; col. 3, lines 4-31; examples 1-2, Table I)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6, 19, 31, 38-44, 46-47, and 59 rejected under 35 U.S.C. 103(a) as being unpatentable over LaPierre et al. (4,431,519) in view of Walker (6,068,757)

LaPierre does not disclose that the molecular sieve is ZSM-48 and does not disclose a step of hydrotreating the feed.

Walker discloses a hydrodewaxing process by using a ZSM-48 catalyst. Walker also discloses that the feedstock has been hydrotreated to remove sulfur compounds and nitrogen. (See col. 3, lines 16-19; claims 1 and 6)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of LaPierre by using a ZSM-48 as taught by Walker because Walker teaches that ZSM-48 has an equivalent function as ZSM-5 in a hydrodewaxing process.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of LaPierre by preliminary treating the feed before hydrodewaxing as taught by Walker because such treating step would improve the product and prolong the activities of the dewaxing catalyst.

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Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claim 28 above, and further in view of Walker (6,068,757)

LaPierre does not specifically disclose the catalyst is sulfided

Ward discloses a dewaxing process wherein the catalyst is sulfided before use.

It would have been obvious to one having obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of LaPierre by sulfiding the catalyst before using as taught by Ward because sulfiding the catalyst would prolong the activities of the catalyst when using a feedstock comprising sulfur compounds.

Claims 13, 25, 53, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaPierre et al. (4,431,519) in view of either Ward (5,447,623) or Carroll et al. (6,517,704)

LaPierre does not specifically disclose the catalyst is sulfided

Ward discloses a dewaxing process wherein the catalyst is sulfided before use. (See Ward col. 7, lines 48-54; col. 10, lines 59-61)

It would have been obvious to one having obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of LaPierre by sulfiding the catalyst before using as taught by Ward because sulfiding the catalyst would prolong the activities of the catalyst when using a feedstock comprising sulfur compounds.

Conclusion

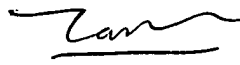
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (571) 272-1452. The examiner can normally be reached on Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tam M. Nguyen
Examiner
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4/30/05

TN